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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/147,405	04/01/1999	BENGT GUSS	REF/GUSS/P33	1676

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BACON & THOMAS  
625 SLATERS LANE 4TH FLOOR  
ALEXANDRIA, VA 223141176

EXAMINER

DEVI, SARVAMANGALA J N

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 04/09/2003

33

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/147,405

Applicant

Guss et al.

Examiner

S. Devi, Ph.D.

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 31, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 ~~is~~/are pending in the application.
- 4a) Of the above, claim(s) 2-24 and 26-29 ~~is~~/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 25, and 30 ~~is~~/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☒ Other: Corrected pages from Sequence Listing.

### **DETAILED ACTION**

#### **Request for Continued Examination**

1) A request for continued examination under 37 C.F.R 1.114, including the fee set forth in 37 C.F.R 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R 1.114, and the fee set forth in 37 C.F.R 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R 1.114. Applicants' submission filed on 12/31/02 (paper no. 29) has been entered.

#### **Applicants' Amendment**

2) Acknowledgment is made of Applicants' amendment filed 12/31/02 (paper no. 31) in response to the final Office Action mailed 08/06/02 (paper no. 26). With this, Applicants have amended the specification.

#### **Status of Claims**

3) Claims 31 and 32 have been canceled via the amendment filed 12/31/02.

Claims 1, 8, 9, 25 and 30 have been amended via the amendment filed 12/31/02.

Claims 1-30 are pending.

Claims 2-24 and 26-29 have been withdrawn from consideration as being directed to non-elected inventions. See 37 C.F.R 1.142(b) and M.P.E.P § 821.03.

Claims 1, 25 and 30 are under examination.

#### **Sequence Listing**

4) Acknowledgment is made of Applicants' submission of the substitute Sequence Listing filed 02/05/03 (paper no. 31). The CRF error with regard to the amino acid numbering in SEQ ID NO: 15 has been corrected by STIC Systems Branch as indicated in the attached sheets.

#### **Prior Citation of Title 35 Sections**

5) The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office Action.

#### **Prior Citation of References**

6) The references cited or used as prior art in support of one or more rejections in the instant Office Action and not included on an attached form PTO-892 or form PTO-1449 have been

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previously cited and made of record.

### **Specification**

7) The instant specification is objected to for the following reasons:

(a) The amendment introduced via the papers filed 07/20/01 to page 10 of the specification beginning at line 6 recites the amino acid sequence, LPDTG, and the amendment introduced via the papers filed 07/20/01 to page 2 of the specification, especially the description for Figures 6A-6E, recites the amino acid sequence, LPXTG. These amino acid sequences contain more than four amino acids, yet are not identified, by SEQ ID NO.s as required under 37 C.F.R. 1.821 through 1.825.

(b) Figures 6A-6E depict an amino acid sequence that is longer than four amino acids in length. Yet, this amino acid sequence is not identified by a SEQ ID NO either in the Figure itself or under the brief description for Figure 6, as required under 37 C.F.R. 1.821 through 1.825.

Any sequences recited in the instant specification which are encompassed by the definitions for nucleotide and/or amino acid sequences as set forth in 37 C.F.R. 1.821(a)(1) and (a)(2) must comply with the requirements of 37 C.F.R. 1.821 through 1.825. All SEQ ID numbers recited in the specification and/or the claims must be included in the Sequence Listing. Note that branched sequences are specifically excluded from this definition.

**APPLICANT MUST COMPLY WITH THE SEQUENCE RULES WITHIN THE SAME TIME PERIOD AS IS GIVEN FOR RESPONSE TO THIS ACTION, 37 C.F.R. 1.821 - 1.825.** Failure to comply with these requirements will result in ABANDONMENT of the application under 37 C.F.R. 1.821(g).

### **Drawings**

8) Acknowledgment is made of Applicants' second amendment proposal submitted 12/31/02 (paper no. 30) for Figures 6A-6D. The amendment overcomes the Examiner's objection to the drawings and/or Figure 6 labels. See paragraph below for Draftsperson's objections to the drawings.

### **Objection(s) Maintained**

9) The objection to the drawings made in paragraph 2 of the Office Action mailed 05/09/00 (paper no. 13) under 37 C.F.R. 1.84 because of the reasons set forth by the Draftsperson in the

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attached Form PTO 948 (paper no. 13) is maintained for reasons set forth therein.

**Objection(s) Withdrawn**

10) The objection to the specification made in paragraph 7 of Office Action mailed 08/06/02 (paper no. 26) is withdrawn in light of Applicants' amendments to the specification.

**Rejection(s) Moot**

11) The rejection of claim 32 made in paragraph 11(b) of the Office Action mailed 08/06/02 (paper no. 26) under 35 U.S.C. § 112, second paragraph, as being indefinite, is moot in light of Applicants' cancellation of the claim.

12) The rejection of claims 31 and 32 made in paragraph 12 of the Office Action mailed 08/06/02 (paper no. 26) under 35 U.S.C. § 112, first paragraph, as containing new subject matter, is moot in light of Applicants' cancellation of the claim.

**Rejection(s) Withdrawn**

13) The rejection of claims 1 and 25 made in paragraph 10 of Office Action mailed 05/29/02 (paper no. 25) and maintained in paragraph 8 of the Office Action mailed 08/06/02 (paper no. 26) under 35 § U.S.C. 102(b) as being anticipated by the patent DE 3583987 A1, is withdrawn in light of Applicants' amendments to the claims and/or the base claim.

14) The rejection of claims 1 and 25 made in paragraph 10 of Office Action mailed 05/29/02 (paper no. 25) under 35 § U.S.C. 102(b) as being anticipated by Fiedler *et al.* (EP 350810 A or B) and maintained in paragraph 9 of the Office Action mailed 08/06/02 (paper no. 26), is withdrawn in light of Applicants' amendments to the claims and/or the base claim.

15) The rejection of claims 1 and 25 made in paragraph 10 of Office Action mailed 05/29/02 (paper no. 25) and maintained in paragraph 10 of the Office Action mailed 08/06/02 (paper no. 26) under 35 § U.S.C. 102(e) as being anticipated by Katz *et al.* (US 6,107,068), or Alborn *et al.* (US 5,587,307), is withdrawn in light of Applicants' amendments to the claims and/or the base claim.

16) The rejection of claims 25 and 30 made in paragraph 11(a) of the Office Action mailed 08/06/02 (paper no. 26) under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendments to the claims.

17) The rejection of claims 1, 25 and 30 made in paragraph 12 of the Office Action mailed

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08/06/02 (paper no. 26) under 35 U.S.C. § 112, first paragraph, as containing new subject matter, is withdrawn in light of Applicants' amendments to the claims.

18) The rejection of claims 1 and 30 made in paragraph 15 of the Office Action mailed 08/06/02 (paper no. 26) under 35 U.S.C. § 103(a) as being unpatentable over Fiedler *et al.* (EP 350810 A or B, already of record), or McDevitt *et al.* (*Mol. Microbiol.* 11: 237-248, 1994) in view of Marston *et al.* (*In: Methods in Enzymology, Guide to Protein Purification.* (Ed) MP Deutscher. vol. 182, section 20, pages 264-276, 1991), is withdrawn in light of Applicants' amendments to the claims and/or the base claim.

#### **Rejection(s) under 35 U.S.C. § 101**

19) Claim 1 and claims dependent therefrom, are rejected under 35 U.S.C. § 101 as being directed to a non-statutory subject matter. The recitation "a polypeptide" in line 2 of claim 1 reads on a product of nature, i.e., naturally occurring polypeptide, or a polypeptide that is present on the surface of a naturally occurring *Staphylococcus epidermidis*. Claim 1 lacks limitations which distinguish the product from those that may exist naturally. Consequently, the claim does not embody patentable subject matter as defined in 35 U.S.C § 101. See MPEP 2105. It is suggested that Applicants use a limitation, such as, --isolated--, or --purified--, in connection with the polypeptide product to reflect the hands of the inventors in the production or creation of the recited product, if such a limitation is supported in the instant specification.

#### **Rejection(s) under 35 U.S.C. § 112, Second Paragraph**

20) Claims 25 and 30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 25 and 30 lack antecedent basis for the limitation "or polypeptide according to claim 1". Claims 25 and 30 depend from claim 1 which already recites 'a polypeptide'. For clarity, antecedence and in order to claim the subject matter distinctly, it is suggested that Applicants replace the recitation with --or the polypeptide according to claim 1--.

#### **Remarks**

21) Claims 1, 25 and 30 stand rejected.

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22) Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center located in Crystal Mall 1. The transmission of such papers by facsimile must conform with the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The CM1 facsimile center's telephone number is (703) 308-4242, which is able to receive transmissions 24 hours a day and 7 days a week. The RightFax number for submission of before-final amendments is (703) 872-9306. The RightFax number for submission of after-final amendments is (703) 872-9307.

23) Any inquiry concerning this communication or earlier communication(s) from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (703) 308-9347. A message may be left on the Examiner's voice mail service. The Examiner can normally be reached on Monday to Friday from 7.15 a.m to 4.15 p.m. except one day each bi-week which would be disclosed on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

April, 2003

  
S. DEVI, PH.D.  
PRIMARY EXAMINER